

REMARKS

As a preliminary matter, Applicants' Counsel wishes to extend his gratitude to Examiner Prebilic for the courtesies extended during the telephonic interview of November 20, 2002. During this interview, and in relation with the outstanding Communication, the Examiner clarified the Communication by explaining that notwithstanding the new claims which obviate the restriction requirement, Applicant is required to select from among the plurality of species identified in the Office Action mailed October 3, 2002.

In response, Applicants provisionally elect, with traverse, the following:

With respect to Group I, Applicants select R<sup>1</sup> to be

O  
II  
— C — N —

With respect to Group II, Applicants select oxygenated polyolefins.

With respect to Group III, Applicants select pharmaceutical salts.

Applicants respectfully submit that the currently-pending claims (claims 13-30) read on the elected species.

Applicants also respectfully request reconsideration of the restriction requirement. The Manual of Patent Examining Procedure ("MPEP") explains the requirements for a proper restriction requirement. In particular, the MPEP states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

M.P.E.P. § 803 (emphasis added).

The fact that *both* criteria must be satisfied is made clear by the following statement in the MPEP: “If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803 (emphasis added)).

Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to claims directed to a Markush claim, the MPEP explains that if the members of a Markush group are sufficiently few in number or so closely related that a search and examination can be made without serious burden, the Examiner must examine all of the claims on the merits, even if they are directed to independent and distinct inventions.

Applicants respectfully submit that the examination of Groups I, II and III would not place an undue burden on the Examiner. In particular, while R<sub>1</sub> is directed to one of two possible moieties, Applicants respectfully submit that a prior art search on the subject matter of R<sub>1</sub> would not pose a substantial burden on the Examiner. The moieties, though distinct, are related such that a prior art search directed to the claimed invention would reveal art directed to both moieties. Applicants note that in the parent application the Examiner searched for both moieties. Accordingly, it is respectfully submitted that a search of both moieties would not constitute an undue burden on the Examiner.

Turning to Groups II and III, Applicants respectfully submit that the Markush group identified therein are both few in numbers and closely related that a search and examination would not an unduly burden the Examiner. Applicants also note that the

parent application (U.S. Serial No. 08/713,800) was examined by the instant Examiner and issued with an independent claim reciting:

R<sub>2</sub> is a spacer group selected from the group consisting of oxygenated polyolefins, aliphatic polyesters, polyamino acids, polyamines, hydrophilic polysiloxanes, hydrophilic polysilazanes, hydrophilic acrylates, hydrophilic methacrylates, linear polysaccharides and lightly branched polysaccharides; and R<sub>3</sub> is a bio-active agent selected from the group consisting of antithrombogenic agents, antibiotics, antibacterial agents, antiviral agents, pharmaceutical salts thereof and mixtures thereof.

Since during the prosecution of the parent application the Markush recitation of R<sub>2</sub> and R<sub>3</sub> (corresponding to Groups II and III, respectively) were not found to cause an undue burden on the Examiner, Applicants respectfully submit that such a burden would not be imposed on the Examiner during this prosecution.

For at least these reasons Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

Turning to the Examiner's request for identification of any copending application, Applicants submit that as of the date of this communication, there is no copending application claiming the same subject matter and assigned to the same inventor. As discussed, the instant application is a continuation of Application Serial No. 08/713,800 ("the '800 application") which issued to U.S. Patent No. 6,306,165 B1.

Finally, in response to the Examiner's inquiry concerning support for the claims added along with Applicants' response of November 1, 2002, Applicants respectfully note that the claims find support throughout the specification as each of the currently-pending claims (claims 13-30) were originally filed as claims 9-23 in the '800 application. During the prosecution of the '800 application, these claims were withdrawn from consideration without prejudice or disclaimer in response to the Examiner's restriction requirement. (See Office Action mailed June 12, 1997 (paper

No. 5) for the '800 application.) For at least this reason, Applicants respectfully submit that each of claims 13-30 is adequately supported by the specification.

CONCLUSION

Applicants respectfully request reconsideration and withdrawal of the restriction requirement and a speedy issuance of a substantive action on the merits. If any point remains that is deemed best resolved through a telephonic interview, the Examiner is respectfully invited to contact the undersigned attorney.

Although no fee is believed to be due, the Office is hereby authorized to charge any outstanding fee, including an extension of time fee, against Deposit Account Number 11-0600 to KENYON & KENYON.

Respectfully submitted,

Date: Dec 4, 2002

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